



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,963	08/10/2001	David K. Lee	F-260	6878

919 7590 11/20/2007  
PITNEY BOWES INC.  
35 WATERVIEW DRIVE  
P.O. BOX 3000  
MSC 26-22  
SHELTON, CT 06484-8000

EXAMINER
----------

JABR, FADEY S

ART UNIT	PAPER NUMBER
----------	--------------

3628

MAIL DATE	DELIVERY MODE
-----------	---------------

11/20/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/927,963	<b>Applicant(s)</b> LEE ET AL.	
	<b>Examiner</b> Fadey S. Jabr	<b>Art Unit</b> 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

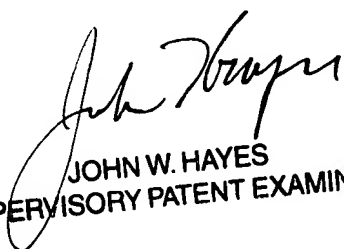
1. In view of the Appeal Brief filed on 31 October 2007, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

  
JOHN W. HAYES  
SUPERVISORY PATENT EXAMINER

*Status of Claims*

Claims 1-2 and 4-10 remain pending and are again presented for examination.

*Drawings*

2. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawing are informal. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

*Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The recitation, "without the sender having knowledge of the unique carrier generated identifier" has not been found within the specification to a degree to overcome the 35 U.S.C. 112, first paragraph, requirement.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 4-5 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bilibin et al., Pub. No. US2005/0197892 A1 hereinafter referred to as Bilibin.

As per **Claims 1-2**, Bilibin discloses a method comprising:

- inducting the mail item into the carrier distribution system, the mail item having thereon a unique sender generated identifier (0416, also see Figure 56-58);
- the carrier tracking the location of the mail item through the carrier distribution system using the unique carrier generated identifier (0436, 0449);
- allowing the sender to obtain location information about the mail item using the unique sender generated identifier by receiving at the carrier distribution system a request from the sender for location information about the mail item, the request including the unique sender generated identifier but not the unique carrier generated identifier (0435-0436).

Bilibin fails to *explicitly* disclose obtaining the unique sender generated identifier from the mail item during processing of the mail item in the carrier distribution system; assigning a unique carrier generated identifier to the mail item during processing of the mail item in the carrier distribution system; associating the unique sender generated identifier with the unique carrier

generated identifier during processing of the mail item in the carrier distribution system; without the sender having knowledge of the unique sender generated identifier.

However, Bilibin discloses after the seller has completed printing the label the seller must give the package to the carrier so that it can be delivered via the carrier (0401). Each carrier assigns each package a tracking number that uniquely identifies each package and which is used to trace packages as the package moves through the particular Carrier's system to the package's destination. A system tracking number is a unique number generated internally by the system to identify a particular package shipped using the system. Each system tracking number corresponds to exactly one carrier-specific tracking number (0413-0414, 0423, 450). Further, Bilibin discloses allowing a user to enter either a system (sender) tracking number or a carrier tracking number (0435-0436, 0450), therefore a sender does not need to know the carrier tracking number to determine the location information of the package. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Bilibin to obtain and associate the sender and carrier identifiers during mail processing seeing as the carrier in Bilibin assigns the tracking number in order to track and trace the package when the package is picked up by the carrier, because it allows the carrier to use their own identifier to track and trace the sender's package throughout the carrier's system.

7. Claims 4-5 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bilibin in view of Wheeler et al., Pub. No. US2002/0032623 A1, hereinafter referred to as Wheeler.

As per **Claim 4**, Bilibin fails to explicitly disclose that the unique sender generated identifier is in a barcode form. However, Wheeler discloses a label containing a bar code that along with the ID comprises a unique tag (0038). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Bilibin and include a barcode as taught by Wheeler, because it allows the system to encode pertinent information in machine-readable format.

As per **Claim 5**, Bilibin discloses wherein the mail item has a recipient address printed there on and the unique sender generated identifier is located on the mail item proximate the recipient address. (see Figure 58). In response to applicant's argument that the reference does not use the unique sender generated identifier to locate the recipient address, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

As per **Claim 9**, Bilibin discloses uniquely associating the uniquely associating the unique sender generated and unique carrier generated identifiers by storing them in a file (0449).

As per **Claim 10**, Bilibin fails to *explicitly* disclose reading the unique carrier generated identifier at a plurality of locations throughout the carrier distribution system, storing in the file a date stamp, a time stamp, and a location identifier each time the reading of the unique carrier generated identifier occurs, and associating in the file the date stamp, time stamp, and location

identifier with the unique carrier generated identifier and the unique sender generated identifier. However, Bilibin discloses a package table storing Package Tracking State ID; Package Shipping State ID; Actual Delivery Time; Delivered To information; Shipping Date; Carrier Tracking Number; System Tracking Number; Carrier ID; Actual Package Weight; Service Description; and Package OID (0122). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Bilibin and include a variety of criteria matches for mail item status queries, because it allows the system user to make use of a collection of mail item data to retrieve status information concerning the location of the mail item.

8. Claims 6-8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bilibin in view of Park et al., Pub. No. US2001/0010334 A1.

As per Claim 6-8, Bilibin fails to *explicitly* disclose wherein the unique sender generated identifier includes an address and further comprising the carrier obtaining the address from the unique sender generated identifier and supplying to the address information about the location of the mail item, wherein the unique sender generated identifier includes an electronic address and additional data that uniquely identifies the mail item. However, Bilibin discloses e-mail notification to the sender (0326). Furthermore, Park et al. teaches notifying the state in which the mail item is being processed on the E-mail address of a sender, so that the sender can know the processing procedure of the mail item (0012). Further, Park et al. teaches a user registering his/her zip code and E-mail address, etc. into a postal service server in the postal



office and then inputting a zip code and name of the recipient. Then, the postal service server receives them to generate information frame to be printed on 4-state barcode and a code word for error correction and then transmits the formation frame and the code word to a barcode printing system to print a customer's barcode (0020). Moreover, Park teaches providing the customer with information during processing of a mail item (0011). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Bilibin and include generating information frame to be printed on 4-state barcode using all of the above data as taught by Park et al., because it provides a considerable amount of information regarding the mail item and sender/recipient of the mail item onto the mail item, where the information is used to sort the mail item and notify the mail customer of the status of the mail item.

### ***Conclusion***

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadey S. Jabr whose telephone number is (571) 272-1516. The examiner can normally be reached on Mon. - Fri. 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fadey S Jabr  
Examiner  
Art Unit 3628

FSJ

Application/Control Number:  
09/927,963  
Art Unit: 3628

Page 10

Please address mail to be delivered by the United States Postal Service (USPS) as follows:

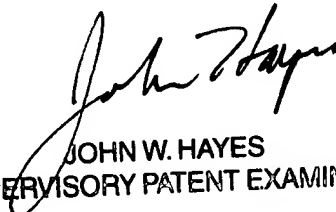
***Commissioner of Patents and Trademarks***

***Washington, D.C. 20231***

or faxed to:

**(571) 273-1516** [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314

  
JOHN W. HAYES  
SUPERVISORY PATENT EXAMINER